

REMARKS

This application has been amended in a manner that is believed to place it in condition for allowance at the time of the next Official Action.

Claims 1-8 and 10-16 are pending in the present application. By way of the present amendment, claims 1 and 10-12 have been amended to more particularly point out and distinctly claim the invention. Claim 9 has been canceled and new claims 14-16 have been added. Support for new claims 14-16 may be found in the present specification at page 5, last paragraph; pages 44-46; and pages 47-51.

It is believed that the present application has been amended in a manner that places it in condition for allowance at the time of the next Official Action.

In the outstanding Official Action, the abstract was objected to for allegedly not reciting chemical structures and referring only to the compositions of the present invention. However, the Examiner's attention is respectfully directed to the abstract filed on February 13, 2002, wherein the abstract clearly recites formulas I and Ia. Moreover, the abstract explains that the compounds of the present invention act as antitumoral medicines. For the Examiner's convenience, a copy of the abstract is enclosed with the present amendment.

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In the outstanding Official Action, claims 1-3 were rejected under 35 USC §102(a) as allegedly being anticipated by MATSUMOTO et al. This rejection is respectfully traversed.

Applicants respectfully submit that MATSUMOTO et al. fails to qualify as prior art.

Initially, it should be pointed out that the present application was filed under 35 USC 371 as the national stage of international application PCT/FR00/02313, which has an international filing date of August 11, 2000. In addition, the international application claims priority to an earlier French application filed on August 13, 1999, a certified copy of which has been received, and acknowledged by the Examiner's Official Action. A certified copy is enclosed for the Examiner's convenience.

In addition, submitted herewith is an English translation of Applicants' earlier corresponding French patent application, certified as accurate by an official translator. In accordance with §201.15 of the Manual of Patent Examining Procedure, it will be seen that Applicants are entitled to a priority date of August 13, 1999, under the provisions of 35 USC 119. Accordingly, Applicants respectfully submit that MATSUMOTO et al. fails to qualify as prior art. As a result, Applicant respectfully requests that the rejection be withdrawn.

Claim 12 was rejected under 35 USC §112, first paragraph, as allegedly being based on a non-enabling disclosure. This rejection has been obviated by the claimed invention.

Claim 12 has been amended to recite a method for the treatment of a solid and/or hematological malignancy in a patient. Applicants respectfully submit that the claimed invention is clearly supported by the present disclosure.

Applicants note that the present disclosure provides an extensive amount of data that supports the claimed invention. Indeed, the recitation of "solid tumors" is supported in the present specification by the extensive series of *in vitro* test on human solid cancer cells. Applicants believe that the *in vitro* test data in the present application (two glioblastoma tests; an astrocytoma test; two non-small-cell-lung cancer tests; two colorectal cancers; two breast cancers; two bladder cancers; and a prostate cancer) clearly demonstrates the cytotoxic activity exhibited by the claimed compound. Indeed, the present specification demonstrates that significant inhibitory activity on cell proliferation was obtained.

Moreover, tests were also conducted *in vivo* against a hormone insensitive mouth mammary carcinoma and a hormone sensitive mouth mammary adeno-carcinoma as well as a lymphoma.

Applicants believe that the recitations directed to hematological malignancies are further supported by the *in vivo*

results obtained in animal models of lymphoma (see present specification, page 52, paragraph 3.3). Indeed, Applicants note that outstanding Official action fails to provide any evidence to the contrary. In view of the *in vitro* and *in vivo* data set forth in the present application, it is believed that the present disclosure clearly supports the claimed invention which is directed to solid tumors and hematological malignancies.

Thus, Applicants believe that the claimed invention is supported by an enabling disclosure and that the rejection must be withdrawn.

In the outstanding Official Action, claims 1-12 are rejected under 35 USC §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicants believe that the present amendment obviates this rejection. In imposing the outstanding Official Action contends that the formulas found in claim 1, 10 and 11 were not clear. In the interest of advancing prosecution, claims 1, 10 and 11 have been amended and clearer copies of the formulas have been provided.

The outstanding Official Action also alleged that the term "Boc" was indefinite. The claims have been amended so that the term "Boc" has been deleted and the term "tert-butoxycarbonyl"

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has been inserted. Thus, it is believed that the claimed invention is definite to one of ordinary skill in the art.

Claim 9 was rejected under 35 USC §101 and 35 USC §112, second paragraph, for allegedly being directed to a "use" without reciting any process steps. This rejection has been obviated by the present amendment.

As noted above, claim 9 has been cancelled.

Thus, in view of the above, it is believed that this application is now in condition for allowance, with claims 1-8 and 10-16, as presented. Allowance and passage to issue on that basis are accordingly respectfully requested.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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APPENDIX:

The Appendix includes the following item(s):

- a copy of the Abstract of the Disclosure filed on February 13, 2002 and the USPTO stamped postcard receipt showing such filing
- priority document and verified English translation

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ATTACHED IS A NEW NATIONAL STAGE APPLICATION

INVENTOR(S): Evelyne DELFOURNE, Francis DARRO, Jean BASTIDE,
Robert KISS and Armand FRYDMAN

TITLE: PHENANTHROLINE-7-ONE DERIVATIVES AND THEIR
THERAPEUTIC USES

FILING DATE: February 13, 2002

CONSISTING OF:

- Transmittal letter
63 Pages of specification (English) w/ 13 claims
 0 Sheets Of Formal Drawings Abstract
 Application Data Sheet Pre. Amend. w/~~marked~~ up version
 Priority doc. (1) - Appln. No.
 Executed declaration (1) Exec. Assignment w/PTO-1595
 Info. Disclosure Statement w/1449 Search Report
 2 Cited References Check # 22179 for \$930.00

OTHER: PCT/IPEA/409, PCT/ISA/210, PUBLISHED APPLICATION (in
French language)

USPTO - PLEASE STAMP RECEIPT DATE AND APPLICATION NUMBER

bam

FEB 13 2002

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